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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/237,183 01/26/99 CHEIKH

022930 HM22/1004
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EXAMINER	
N	04983.0015.U
ART UNIT	PAPER NUMBER

BENZION, G
DATE MAILED:

1638

10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/237,183

Applicant(s)
Chelkh et al

Examiner
Gary Benzion, Ph.D.

Group Art Unit
1638



☒ Responsive to communication(s) filed on 2 Nov 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-6 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-6 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Status of the Application

Claims 1-6 are pending.

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2 drawn to a substantially purified nucleic acid molecule that encodes a maize or a soybean enzyme or fragment thereof wherein said nucleic acid molecule is selected from the group of 15 enzymes recited in claim 1, and wherein said purified nucleic acid molecule is selected from the group consisting of SEQ ID's 1-2814, classified in class 536, subclasses 23.1, 23.5, and 24.3, class 435, subclasses 6, 69.1, 320.1, 240.1, and 252.33, for example.
- II. Claim 3-4, drawn to a substantially purified maize or soybean enzyme that or fragment thereof wherein purified enzyme is selected from the group of 15 enzymes recited in claim 1, and wherein said purified enzyme is selected from the group consisting of SEQ ID's 1-2814, classified in class 435, subclass 183.
- IV. Claim 5-6, drawn to a transformed plant having an exogenous promoter which functions in plant cells to cause the production of a mRNA of structural nucleic acid molecule comprising the nucleic acid molecule selected from the group consisting of sequences a-p, as set forth in claim 5 and further comprising a 3'-non-translated region, and further still to a transformed plant according to claim 5 in which the structural gene is complementary to any of the nucleic sequence in a-o of claim 5, classified in 800, subclass 298, for example.

The inventions are distinct, each from the other for the following reasons.

Groups I-III are independent and distinct from each other because purified nucleic acid molecule of Group I are materially different from, and are therefore independent and distinct from, the polypeptides of group II, and are also materially different from the plants of group III. The purified nucleic acid molecule of Group I are not needed to produce the polypeptides of Groups II, as they may be purified from naturally occurring sources or may be synthesized chemically. Similarly, neither are the polypeptides of

Groups II needed to produce any of the purified nucleic acid molecule Group I as they too may be purified from naturally occurring sources or may be synthesized chemically. The purified nucleic acid molecule of Group I are not necessary for the production of any of the plants of Group III as these may be made by using fragments of the polypeptides of Group II. Groups II and III are independent and distinct from the purified nucleic acid molecule of use of group I in that they are not required to practice the invention as claimed.

Additionally, in the event that either Group I or III is elected, applicant is required to specify no more than ten specific nucleotide sequences for examination. This requirement is made under O.G. Notice 1192 O.G. 68 (November 19, 1996), as the examination of more than ten sequences in one application would result in an undue search burden on the PTO. In instances where the elected nucleotide sequences are claimed by clone number, applicant is requested to correlate the elected clone numbers to the specific sequence ID's to facilitate examination.

In the event that either Group II is elected, applicant is required to specify a single enzyme or or sequence ID, respective to the elected group, for examination. This requirement is made as each enzyme is materially different from, and is therefore independent and distinct from each other, as they share no common structural or functional elements and are therefore each patentably distinct.

Summary

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Inquires

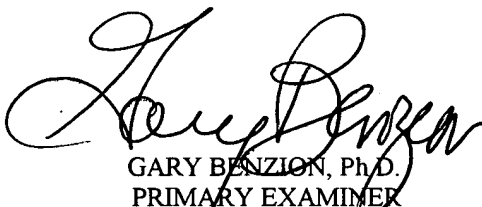
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Any inquiry concerning this or earlier communication from the examiner should be directed to Gary Benzion, Ph.D. whose telephone number is (703) 308-1119. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703)-308-4310. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Benzion
10/02/00


GARY BENZION, Ph.D.
PRIMARY EXAMINER
GROUP ART UNIT 1638